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In re Application of: Redler)
Application No. 09/786,364) DECISION ON PETITION FOR
Attorney Docket No. 1336) SUPERVISORY REVIEW
Filed: 03/15/2001) UNDER 37 CFR §1.181
For: SECURE DATA ENTRY)
PERIPHERAL DEVICE)
)

This is a decision on the request for reconsideration of the petition under 37 CFR § 1.181, filed September 12, 2005, (complete copy faxed September 21, 2005) requesting the Commissioner to invoke his supervisory authority and withdraw the finality of the final Office action mailed April 5, 2005. The original petition under 37 CFR § 1.181, filed July 3, 2005 (copy filed July 5, 2005) was dismissed in a decision mailed August 23, 2005.

The petition is **DENIED**.

RECENT PROSECUTION HISTORY

- (1) On September 21, 2004, a non-final Office action, treating pending claims 1-6, 12-15 and 22, was mailed.
- (2) On December 21, 2004, a response to the non-final Office action was filed, in which independent claims 1, 22 and dependent claim 15, were amended. Note claims 2-6 were cancelled and dependent claims 12-14 were not amended.
- (3) On April 5, 2005, a final Office action, treating claims 1, 12-15 and 22 on art of record, was mailed.
- (4) On June 1, 2005, in an interview summary sheet (PTOL-413), copy provided to applicant, the Examiner indicated that proposed amendments after final rejection discussed, although not readily taught from the art applied in the final office action, if added to the claims would represent new considerations resulting in further searching and the mailing of an Advisory Action.

- (5) On July 3, 2005, (duplicate filed July 5, 2005) a petition was filed under 37 CFR § 1.181 to withdraw the final rejection as premature.
- (6) Also on July 3, 2005, (duplicate filed July 5, 2005) an amendment (to independent claims 1 and 22) and response after final was filed.
- (7) On August 10, 2005, an advisory action was mailed indicating that the amendment(s) filed on July 5, 2005 would not be entered as they raised new issues that would require further consideration and/or search. A detailed explanation was included on page 2 of the action.
- (8) On August 23, 2005, a decision dismissing the petition filed July 3, 2005 was mailed.
- (9) On September 21, 2005, the instant petition was filed.

RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests the following relief: 1) reconsideration of the petition decision mailed August 23, 2005; 2) withdrawal of the finality of the April 5, 2005 office action as Applicant believes the final rejection contains a technical inaccuracy; and 3) upon granting of the withdrawal of the finality, entry of the after final amendment filed July 3, 2005.

REQUIREMENTS

A petition under 37 CFR §1.181 must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. Note, the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. In addition § 1.181(f) sets forth: any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. Further, when a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, ... it may be required that there have been a proper request for reconsideration (37 CFR §1.111) and a repeated action by the examiner.

With respect to the request for reconsideration of the petition decision of August 23, 2005, the petition filed on September 21, 2005 includes elements (1) and (2) above, as well as being filed within two months of the dismissal. In accordance with Petitioner's remarks, and in light of the interview summary of June 1, 2005, the reviewer agrees that the initial petition was filed within two months of the dismissal action (final Office action, April 5, 2005) from which relief is requested and thus a proper request for reconsideration (of the propriety of the final rejection) under 37 CFR§1.111 appears in the file.

OPINION

The request for Withdrawal of the Finality of the Office action mailed April 5, 2005, and the request for entry of the after final amendment will now be simultaneously addressed.

Petitioner presents the following arguments in support of the position that the Final rejection was premature:

The **proposed** after final amendment, including the language "public key algorithm" as admitted by the Examiner in the interview summary, does not appear to be disclosed by the reference to Clark ('569) and therefore should be admitted.

The issue exposed in the **proposed** after final amendment relating to the language "adapted for *Internet communication*" has a long prosecution history, including in the examination process with respect to the (related) PCT Written Opinion (PCT/IL99/00504), and therefore the Examiner should have taken the proper search context into account with his initial search. Thus, it is believed that the technical inaccuracy of the final rejection is established.

ANALYSIS

The relevant section of the MPEP concerning finality of Office practice is MPEP § 706.07. In the language of the MPEP:

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. *However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits.*

Neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution; Ex parte Hoogendam, 1939 C.D. 3, 499 O.G.3, 40 USPQ 389 (Comm'r Pat. 1939).

The relevant section of the rules and MPEP concerning entry of amendments after final rejection 37 CFR § 1.113, § 1.114, § 1.116 and MPEP § 714.13 which state in part:

§ 1.113 Final rejection or action.

(c) *Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.*

§ 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141,

(b) *Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.*

§ 1.116 Amendments after final action or appeal.

- (a) An amendment after final action or appeal must comply with § 1.114 or this section.
- (b) *After a final rejection or other final action (§ 1.113) in an application or an action closing prosecution, amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted.* The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.
- (c) If amendments touching the merits of the application are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

714.13 [R-2] Amendments After Final Rejection

II. ENTRY NOT A MATTER OF RIGHT

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims. Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. *A reply under 37 CFR 1.113 is limited to:*

- (A) an amendment complying with 37 CFR 1.116;*
- (B) a Notice of Appeal (and appeal fee); or*
- (C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e).*

An amendment filed at any time after final rejection, but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions.[emphasis added]

In the review of the claims of an application, it is important to remember that the claims define the property rights provided by a patent, and thus require careful scrutiny. The goal of claim analysis is to identify the boundaries of the protection sought by the applicant and to understand how the claims relate to and define what the applicant has indicated is the invention. Office personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. See *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998).

With respect to Petitioner's argument that the proposed addition (after closing of prosecution) of the language "public key algorithm" does not appear to be shown by the reference and therefore should be admitted, the following analysis is presented.

In a comparison of the final rejection of April 5, 2005 with that of the proposed after final amendment, filed July 3, 2005, one readily determines that the proposed changes to the claims are not consistent with a requirement of form, cancellation of claims or adopting examiner suggestions and therefore do not "remove issues for appeal" or require "only a cursory review by the Examiner". As such, the proposed amendment fails to comply with the provisions set forth in 37 CFR § 1.116 and MPEP § 714.13 identified above. The mere fact that a limitation is not apparent in a prior art reference does not necessarily equate to allowability of such language and claim. It may in fact mean that a new analysis of the claim language must take place in order to properly determine the (new) scope of the claim, and thus the applicability of a (new) grounds of rejection, based upon the changed scope. As is evident by the Examiner's interview summary record (June 1, 2005) and Advisory Action (August 10, 2005), this is clearly the case. That is, the proposed changes to the scope of the claims, requires further consideration and search.

With respect to Petitioner's argument that the issue exposed in the proposed after final amendment relating to the language "adapted for *Internet communication*" has a long prosecution history, including in the examination process with respect to the (related) PCT Written Opinion, and therefore the Examiner should have taken the proper search context into account with his initial search the following rebuttal is offered.

It is noted to Petitioner, that language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. In addition, ***limitations appearing in the specification but not recited in the claim are not read into the claim.*** > E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). Finally, as the claim designer, Applicant is tasked with fashioning claims that are "precise, clear, correct, and unambiguous". Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process (see MPEP 2106).

Since the claim language in question was not set forth until after prosecution on the merits was closed (i.e. in the proposed after final amendment), the Examiner was not required to import such language from the instant specification.

With respect to PCT application IL99/00504, first it is noted that the same examiners did not examine the instant application and the related PCT application identified. Second, and as stated above, the claims of the (instant) application must be interpreted in view of the (instant) specification without importing limitations from the specification into the claims. It follows logically then that limitations from a related PCT application specification, may not be imported in the claims of the instant application. Finally, there is currently no requirement that the prosecution history of a related PCT application become part of its corresponding U.S. application. The rules, practices and procedures for PCT applications (see MPEP chapter 1800) are not the same as the rules, practices and procedures for U.S. applications. Therefore, contrary to Petitioner's assertion, it has not been successfully shown that a technical inaccuracy exists with respect to the final rejection.

CONCLUSION

Therefore, prosecution of the instant application, including issuance of the final rejection of April 5, 2005 is determined to be proper and consistent with Office policy and practice. In addition, the Examiner's refusal to enter the proposed amendment filed July 3, 2005 is also consistent with Office policy and practice. Accordingly, the petition to compel the examiner to withdraw the finality of the final Office action and to enter the after final amendment is **DENIED**.

Any inquiries related to this decision may be directed to Specials Program Examiner Brian Johnson at (571) 272-3595.

A handwritten signature in black ink, appearing to read "Jack Harvey", is written over a horizontal line.

Jack Harvey
Director, Technology Center 2100
Computer Architecture, Software, and Information Security